

REMARKS

The courtesy of Examiner Katcheves in granting an interview to the applicant's attorney is gratefully acknowledged. The applicant's attorney had requested that Supervisory Primary Examiner Friedman be present at the interview, and he was scheduled to be present, but was unable to attend. Examiner Katcheves gave the applicant's attorney the option of proceeding with the interview or rescheduling. The Examiner agreed to the proposal of the applicant's attorney that the attorney's comments be presented at that time and that, if the Examiner disagreed with the attorney's conclusions as to patentability, the attorney be permitted to present the comments in the presence of Mr. Friedman.

With respect to independent claim 1, it was pointed out at the interview that claim 1 calls for a window frame including window frame members engaging edge zones of the glazing element. In Fig. 3 of the application, a frame member 507 is shown having a portion 508 engaging an edge zone of a glazing element 504. It was also pointed out that claim 1 calls for the window frame to be made of profile material having a second profile wall, and for engaging means (in Fig. 3, roller 533) on an end member (532 in Fig. 3) connected with the screening member to engage the second profile wall. In other words, claim 1 calls for the screening member to be connected to a window frame member that engages the glazing element.

The Moller et al. reference does not have this structure. Instead, a screening element is received in a track 24 that is a part of an inner frame structure 19 having a top flange 20a resting

on the top of a curb wall member 1. Thus, the Moller et al. reference does not satisfy the requirement of claim 1 that the screening member have a part that engages a frame member that engages an edge zone of the glazing element.

At the interview, the Examiner stated that claim 1 appears to be allowable, but that he would do a further search. The Examiner indicated that the same applies to claim 10, which he found to be similar to claim 1.

With respect to independent claim 12, the applicant's attorney pointed out that claim 12 requires the window frame members to engage edge zones of the glazing element, and that it requires the window frame to be made of profile material of substantially L-shaped cross-section comprising a second profile wall providing at an external side thereof a transverse inwards recess. In Fig. 3, the recess is indicated by the reference numeral 511.

In Moller et al., if the external frame profile 11 is considered to be the frame member engaging the edge zone of the glazing element, as is recited in claim 12, and if either the wall to which the numeral 13 points or the wall parallel to it and directly under the numeral 12a is considered to be "the second profile wall" of claim 12, then Moller et al. does not disclose the feature of claim 12 that the second profile wall provides at an external side thereof a transverse inwards recess. The Examiner indicated that he now considers claim 12 to be allowable, but must do a search.

Claim 11 is directed to an external screening accessory comprising: an elongate housing, a screening member accommodated in said housing to be retractable therefrom by movement

perpendicularly to the housing, and an end member connected with a free end of said screening member and extending parallel with the housing, engaging means being provided at either end of said end member. The engaging means at either end are for engagement with a respective side member of a window frame. By the present amendment, claim 11 has been amended to call for the engaging means to be “adapted to engage a transverse inward recess of a respective side member of a window frame”. Fig. 1, for example, shows the elongate housing 519, the screening member 531, the end member 532 and a portion of one of the engaging means 533. Fig. 3 shows more of one of the engaging means 533 and shows that it is adapted to engage a transverse inwards recess of a side member of a window frame. Although the language of an “adapted to” expression might be considered functional, it cannot be disregarded, but must instead be given patentable consideration. Judge Rich dealt with this issue *In re Land and Rogers*, 151 USPQ 621, 635 (CCPA 1966). There, he considered a claim expression that included “inner photosensitive emulsion layers are *adapted to be rendered diffusible* in said liquid composition *only after at least substantial development* of the next outermost photosensitive *** layer has occurred.” The emphasis was that of the court. Judge Rich said that it is true that the italicized portions are “functional” but that the court does not regard that as good ground to give them “no weight”. He said the court gives them weight and thinks that the claims are limited to deferred diffusion *built into the structure recited*.”

Accordingly, it is submitted that claim 11 requires the external screening accessory to have an end member with engaging means at either end of the member, the engaging means

being adapted to engage a transverse inwards recess of a respective side member of a window frame. The Moller et al. reference does not even disclose a screening member accommodated in an elongate housing to be retractable therefrom by movement perpendicularly to the housing. Furthermore, it does not disclose the screening member having a free end with an end member parallel to such a housing, the end member having engaging means adapted to engage a transverse inwards recess of a side member of a window frame, as is required by claim 11. In Moller et al., no engaging means that is adapted to engage a transverse inwards recess of any structure is disclosed. Thus, there is no structure in Moller et al. that satisfies the “adapted to” expression of claim 11 that must be given patentable weight.

The Sorensen reference also fails to disclose any elongate housing and a screening member accommodated in the housing to be retractable therefrom by movement perpendicularly to the housing. Even if the sliding roof of Sorensen et al. were considered to be a screening member, there is no housing that accommodates the sliding roof or from which the sliding roof can be retracted, as is required by claim 11. Furthermore, no part of the sliding roof structure of Sorensen et al. has the structure required by claim 11 of engaging means at either end of an end member of the roof, the engaging means being adapted to engage a transverse inwards recess. The rollers 19 of Sorensen et al. that engage a transverse inwards recess are not on the sliding roof. Thus, even if Moller et al. and Sorensen et al. were combined, the resulting combination would not have the features called for by claim 11. Furthermore, the references themselves do not suggest the combination. The combination would not have been obvious, but was only


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inspired by a knowledge of the applicants' invention. Thus, it is submitted that claim 11 is allowable.

A Notice of Allowance is respectfully requested.

Respectfully submitted,

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